

Attorney Docket No. 9389-2
Application Serial No. 10/822,408
Filed: April 12, 2004
Page 10

REMARKS

This response is submitted in reply to the Office Action mailed on August 23, 2004 ("the Action"). Claims 1-36 are pending in the application. Claims 22-36 were withdrawn from consideration by the Examiner in response to a telephonic provisional election with traverse of Claims 1-21 by the undersigned. Applicants hereby affirm the provisional election of Claims 1-21. In order to advance prosecution, Applicants have cancelled Claims 22-36 above without prejudice thereto for pursuit in a divisional application(s).

Allowable Claims

Applicants acknowledge, with appreciation, the Examiner's statement that Claims 11-20 would be allowable if rewritten or amended to overcome the §112, second paragraph rejection. Applicants have amended Claims 6, 11 and 12 to obviate the noted informalities. Applicants have also amended Claim 11 to be in independent form and to incorporate the subject matter of Claim 1. Claims 12-20 depend from Claim 11. Accordingly, Applicants respectfully submit that Claims 11-20 are in condition for allowance, which action is requested.

The Drawing Objection

Applicants have attached amended Figure 1 to add the "Prior Art" label suggested in the Action and request that this objection be withdrawn.

The §112 Rejection, First Para. Rejection

Applicants strongly disagree with the Examiner's statement that Claim 3 is rejected for having subject matter "that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention." The Action surmises that this position is taken because Claim 3 refers to a second punch path with a second clip window "which was broadly described on the specification (page 5, 2nd paragraph) which was not clear how it works in view of the 1st

Attorney Docket No. 9389-2
Application Serial No. 10/822,408
Filed: April 12, 2004
Page 11

punch path with a first clip window." However, the dual punch path feature is well known to those of skill in the art and is described in the background of the instant application. Further, exemplary apparatus with dual punch paths are described by patents incorporated by reference in the pending application. However, Applicants have attached new Figure 8C which illustrates two side-by-side (axially spaced apart) punch paths to illustrate an example of a dual punch path embodiment (as recited in Claim 3). Figure 8C provides the two punch paths by positioning two of the devices shown in Figure 8B side-by-side.

To be clear, although the two punch paths shown in Figure 8C have the same punch configuration and/or selective retraction and advancement mechanism (such as two of the devices shown in Figures 8A and 8B), the invention is not limited thereto, as dissimilar punch configurations or embodiments can be used as is known to those of skill in the art. That is, in some embodiments, the first and second punch paths may employ differently configured clipping devices, such as, but not limited to, one of the punching configurations used in one of the two punch paths shown in the double clipper apparatus described in U.S. Patent 5,495,701, incorporated by reference in the pending application (p. 2, lines 33-34). *See also* other patents identified at pp. 2-3 of the pending application, at least some of which employ dual clip paths. In any event, the dual clip paths can be configured so that two spaced apart clips may be applied to a target product generally concurrently as is known to those of skill in the art. In view of the above, Applicants respectfully request that the drawing objections and the Claim 3 rejection be withdrawn.

The Art Rejections

The Action rejects Claims 1, 2, 6-10 and 21 as being anticipated by U.S. Patent No. 5,586,424 to Chen et al. ("Chen") and Claims 4 and 5 as being obvious in view of Chen. The Action also rejects Claim 3 as being obvious over Chen in view of U.S. Patent No. 5,495,701 to Poteat et al. ("Poteat"). Applicants respectfully disagree.

Chen describes a dual pusher pawl, which is configured to provide a more reliable feeding force. Chen employs an engagement/disengagement device with a linear actuator 38. There is no active forcing or active retracting of clips away from the clip punch path. Indeed,

Attorney Docket No. 9389-2
Application Serial No. 10/822,408
Filed: April 12, 2004
Page 12

as recited at col. 3, lines 36-40, "surface 68 insures that when the arm 42 is moved in the upward direction opposite the desired direction of driving the clips 14, the surface 68 will slide over the clips 14 and will not move the clips upwardly along the guiderail 22." (emphasis added).

Similarly, the Poteat reference mechanically selects 1 or 2 clips and employs a punch assembly (24, 30) to engage or disengage the clips. When not activated for clipping, the device leaves the clips in position and does not actively force the clips away from the direction of the clip driving during active clipping.

Claim 1 recites in-part:

"automatically, selectively, and forcibly retracting the plurality of clips so that the clips travel in a reverse direction along the first predetermined clip travel path away from the first punch path..." (emphasis added)

Claim 21 recites in-part:

"automatically selectively pulling the plurality of clips so that the clips travel in a reverse direction along the first predetermined clip travel path..." (emphasis added)

In view of the foregoing, Applicants respectfully submit that the claims are patentable over the cited references as, *inter alia*, neither reference teaches forcing the clips away from the clip punch path.

New Claims

Applicants have added new dependent Claims 37-45 to depend from Claim 21. The claims are supported by the specification and generally correspond to the original dependent claims that depend from Claim 1. Applicants respectfully request entry and consideration of same.

Attorney Docket No. 9389-2
Application Serial No. 10/822,408
Filed: April 12, 2004
Page 13

Conclusion

Accordingly, Applicant submits that the present application is in condition for allowance and the same is earnestly solicited. Should the Examiner have any matters outstanding of resolution, he is encouraged to telephone the undersigned at 919-854-1400 for expeditious handling.

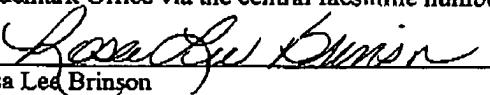
Respectfully submitted,


Julie H. Richardson
Registration No.: 40,142

USPTO Customer No. 20792
Myers Bigel Sibley & Sajovec
Post Office Box 37428
Raleigh, North Carolina 27627
Telephone: 919/854-1400
Facsimile: 919/854-1401

**CERTIFICATION OF FACSIMILE TRANSMISSION
UNDER 37 CFR 1.8**

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office via the central facsimile number 703-872-9306 on November 17, 2004.


Rosa Lee Brinson